

P2
transforming the cell with the nucleic acid.--

Please cancel claim 2, and add new claim 17 as follows:

P3
--17. A method of transforming a cell comprising the steps of applying to the cell a nucleic acid in admixture with a fibrin or fibrinogen composition so that the fibrin or fibrinogen composition forms a pliable adhesive fibrin gel adhered to the cell so as to entrap a transformation effective amount of the nucleic acid in the fibrin gel adhered to the cell; and transforming the cell with the nucleic acid.--

Remarks

This amendment is being filed in response to the Official Action mailed in this application on March 12, 2003. By this amendment, the claim for priority in the specification has been amended, claim 1 has been amended, and claim 2 has been canceled and rewritten as new claim 17. Accordingly, claims 1 and 13-17 are now pending in this application. Reconsideration of this application is respectfully requested in view of the above amendments and further in view of the following remarks.

First, the action indicates that a new oath is required. The inventor on this application has died. Accordingly, the undersigned will review the oath and take the necessary steps, if any, to cure any defects that might be in the original oath. In any event, the claim for priority in the first sentence of the application has been amended.

Next, claims 1 and 2 were rejected under 35 USC §112, 2nd paragraph. While it is believed that the claims were clear as written, claim 1 has been amended to state specifically that the steps recited are in order. Additionally, claim 2 has been canceled and rewritten as new claim 17. It is submitted that claim 17, as an independent claim, is not limited by any interpretation of claim 1. Accordingly, it is believed that this rejection has been obviated.

Claims 1, 2 and 13-16 were then rejected under 35 USC §112, 1st paragraph, allegedly as lacking enablement. This rejection is traversed.

The rejection essentially asserts that "[t]he claims read on gene therapy *in vivo*", and since gene therapy was unpredictable at the time of the invention, the claims lack enablement. However, the claims are not directed to gene therapy *per se*. Rather, the claims are directed to transforming a cell. There is nothing in the rejection to say that *transforming a cell* is unpredictable. In fact, the rejection asserts that "progress has been made" in many respects. Accordingly, it is submitted that this rejection is not directed to the claims as written and should therefore be withdrawn.

Finally, claims 1, 2 and 13-16 were rejected under 35 USC §102(e) as anticipated by, or, in the alternative, under 35 USC §103 as obvious over US Patent No. 5833651 ("Donovan"). This rejection is also traversed.

The rejection, in hindsight, concludes what is not suggested in Donovan: that it would be desirable to entrap nucleic acid in a pliable fibrin gel adhered to a cell. But, the suggestion to modify must come from the prior art, not the comfort taken from the roadmap to the invention provided by the applicant's specification. To find motivation to modify in the prior art, that prior art must provide evidence that the combination or modification would be viewed as desirable in the context of the prior art teachings. This desirability must be evidenced by more than a conclusion that the alleged combination is feasible.

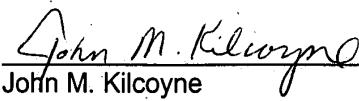
In this application, one of ordinary skill in the art would not, based on Donovan, find it desirable to entrap nucleic acid in a pliable fibrin gel adhered to a cell. Donovan does not teach that it would have been desirable to do so. Accordingly, this rejection should be withdrawn.

In addition, with respect to claims 15 and 16, it is further respectfully submitted that Donovan in no way discloses, suggests or provides any sort of motivation to take the extra steps of using fibrin monomer (which has nothing to do with the "monomer" described in Donovan) or in particular acid-solubilized fibrin. Accordingly, this rejection, particularly as it is applied to claims 15 and 16 should be withdrawn.

In view of the foregoing, reconsideration of this application and allowance thereof with claims 1 and 13-17 are respectfully solicited.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
100 Headquarters Park Drive
Skillman, NJ 08558
(908) 904-2372


John M. Kilcoyne
Attorney for Applicant
Reg. No. 33,100

Date: June 12, 2003

Version showing changes made in the specification

In the specification, line 1:

--This application claims the priority of US Provisional [Application] Applications 60/083571, filed April 30, 1998, and 60/089543, filed June 17, 1998, and is a continuation of US Application 09/303,377, filed April 30, 1999.--

Version showing changes made in the claims

In the claims:

- 1. (Twice Amended) A method of transforming a cell comprising in order, the steps of:
applying a transformation effective amount of a nucleic acid to the cell;
adhering a pliable, adhesive fibrin gel to the cell so as to entrap a transformation effective amount of the nucleic acid in the fibrin gel adhered to the cell; and
transforming the cell with the nucleic acid.--